

REMARKS

I. Disposition of Claims

Claims 1 and 4-11 are currently pending. Claims 1 and 9 are currently amended. Claims 1 and 9 are currently amended. Support for the amended claim can be found throughout the specification, for example in the original claims, page 17, line 3 and page 20, lines 10-15, and in Figure 2, 10 and 34. No new matter has been added.

II. Novelty

Claims 1, 4 and 5 were rejected under 35 U.S.C. §102(b) as being anticipated by Botich et al. (US 5,188,599). In order for a claim to be anticipated by a reference, every feature recited in the claim must be found within the reference. The Examiner asserted in his Response to Arguments in the prior Office Action of that "applicant does not clearly claim which side of the flange is deemed to be the rear surface therefore it is the examiner's position that the distal surface (surface closer to the needle) of the flange is the rear surface and therefore Botich still encompasses the limitations of the claim." Despite Applicant's amendments of April 18, 2007, the Examiner maintains the assertion that the front and rear surfaces of the flange have not been defined "...[s]ince no language has been entered which describes the orientations of the rest of the sides to the surfaces of the flanges." Applicant has now clearly defined that the "front" surface of the flange is the side where the syringe tip is located (distal) and that the rear is the proximal surface. See Figure 34, page 17, line 3 and page 20, lines 10-15. Therefore, there is now no ambiguity in construing the claim with regard to the orientation of the projection on the flange.

Botich discloses a projection formed on the front surface of the flange of a syringe, not on the rear surface of the flange as recited in present Claim 1. Furthermore, in Botich the front surface of the flange, which is just opposite the side of the projection, does not touch the front wall of the groove when the flange is inserted into the flange insertion groove. In contrast, the present claims recite that the projection provided on the rear surface of the flange is capable of being compressed when inserted into the flange insertion groove, thereby allowing the front surface of the flange to touch the front surface of the groove. These features are neither disclosed nor suggested by Botich. Thus, Claims 1, 4 and 5 are not anticipated by this reference.

Furthermore, since the front surface of the flange of the syringe barrel receives high pressure when injection of contrast medium is carried out, the front surface of the flange has to be flat and has to contact with the front wall of flange insertion groove of cylinder holder with as large a contact area as possible. If projection is formed on the front surface of flange, like Botich, the projection deforms by high pressure and the stable holding of the flange by flange insertion groove cannot be achieved.

Claim 9 was rejected under 35 U.S.C. §102(b) as being anticipated by Clements et al. (US 5,925,032). Clements does not teach or suggest a projection on a rear inner wall surface of the flange insertion groove configured such that the projection will become deformed when compressed by the insertion by the flange. Thus, Claim 9 cannot be anticipated by Clements.

III. Non-Obviousness

Claim 10 was rejected under 35 U.S.C. 103(a) as being unpatentable over Clements (*supra.*) in view of Stanners. As stated above, Clements neither teaches nor suggests the invention as recited in claim 9. The Examiner asserts that Stanners teaches how to modify Bitdinger to include a concave portion on the rear surface of the flange. However, Stanners does not teach how to modify Clements to include all the limitation of Claim 9 as discussed above. Therefore a *prima facie* case of obviousness cannot be supported and the claim should be allowed.

Claims 6-7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Botich et al. (US 5,188,599). As stated above, Botich neither teaches nor suggests all of the features recited in claim 1. Since claims 6 and 7 depend from claim 1, these claims cannot be obvious in view of this reference because a *prima facie* case of obviousness cannot be established.

Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Botich et al. in view of Bitdinger et al. (US 5,667,495). However, the combination of these references would not lead to the claimed invention. The deficiencies in the teachings of Botich et al. with regard to claim 1 are discussed above. These deficiencies are not cured by Bitdinger which neither teaches nor suggests the features lacking in Botich et al., namely a projection formed on the front surface of the flange of a syringe, and that the projection provided on the rear surface of the flange is capable of being compressed when inserted into the flange insertion groove, thereby allowing the

front surface of the flange to touch the front surface of the groove. Thus, a prima facie case of obviousness cannot be established and claim 8 cannot be obvious over this combination of references.

Claim 11 was rejected under 35 U.S.C. 103(a) as being unpatentable over Botich et al. in view of Ritz (US 3,438,549) or Tompkins (US 4,030,498). The Examiner asserts that Ritz and Tompkins teach pre-filled syringes. As stated above, Botich neither teaches nor suggests all of the features recited in Claim 1. These deficiencies are not cured by Ritz or Tompkins, neither of which teach nor suggest the features lacking in Botich et al., namely a projection formed on the front surface of the flange of a syringe, and that the projection provided on the rear surface of the flange is capable of being compressed when inserted into the flange insertion groove, thereby allowing the front surface of the flange to touch the front surface of the groove. Thus, Claim 11, which depends from Claim 1 or from Claims 4-7 (which are also dependent on claim 1), cannot be obvious in view of this combination of references.

In view of the amendments and comments presented above, applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a).

IV Further Comment by Examiner

During the telephonic interview, the Examiner indicated that the proposed amendment would overcome the art of record. The Examiner also indicated that she was aware of another application for which she was the Examiner in which additional prior art was cited. The Examiner later called the undersigned agent to indicate that the related application was Application No. 10,781,124. Applicants have reviewed the prosecution of this related application, and note the presence of allowable claims in that application. Applicants have also reviewed the prior art cited in that application, namely Fago (US 6,569,127), Reilly (US 6,958,053) and Trull (US 5,947,929). In view of the Examiner's finding of allowable subject matter in the related application, Applicants believe that the pending claims in the present application are similarly allowable.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this

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application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION


In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of all outstanding rejections are respectfully requested. Allowance of the claims at an early date is solicited. If any points remain that can be resolved by telephone, the Examiner is invited to contact the undersigned at the below-given telephone number.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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AMEND

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